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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,569	12/10/2001	Kazuo Iwai	1422-0508P	3472

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER

OLSZEWSKI, JOAN M

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/006,569

Applicant(s)

IWAI, KAZUO

Examiner

Joan M. Olszewski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 21 November 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### DETAILED ACTION

This is in response to Applicant's RCE filed June 09, 2003 and declaration filed October 2, 2003. Currently, claims 11-22 are pending in this application.

With respect to the 35 USC 112 second paragraph rejection corrections these are considered acceptable by the Examiner.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 11-14 of copending Application No. 10/291,473 in view of JP 07135896 A.

The above identified claims of pending applicant's 10/291,473 set forth all of the method steps claimed except for using the process to treat poultry. However, JP 07135896 A teaches that it is well known to use an hinokitiol solution to treat a wide variety of fish and animal meat. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method

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as set forth in the above identified claims of the application by using the process to treat poultry as taught by JP 07135896 A since it is routinely known to use the same type of solution to treat a wide range of edible food stuffs.

This is a provisional obviousness-type double patenting rejection.

Claims 11-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,3,4,6-9, and 14-16 of U.S. Patent No. 6,554,620 in view of Kurschner et al.(US Patent 5,632,676) in view of Nishimoto (US Patent 6,165,964).

The above identified claims of US Patent 6,554,620 set forth all of the method steps claimed except for the treatment occurring during the processing of poultry or the specific PH and temperature. The Kurschner et al. reference teaches the sterilizing treatment of poultry during the processing of the meat at a temperature within the claimed range. The Nishimoto patent teaches the use of hinokitiol solution for sterilization purposes within the claimed PH range. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method as set forth in the above identified claims of the application by utilizing the sterilizing treatment of poultry during the processing of the meat at a temperature within the claimed range as taught by Kurschner et al. in order to provide sterilized poultry meat. Further, by substituting the antibacterial solution hinokitiol within

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the claimed PH range as taught by Nishimoto in order to ensure proper sterilization of the poultry meat during processing.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurschner et al. (U.S. Patent 5,632,676) in view of Nishimoto et al. (U.S. Patent 6,165,964) and Takahashi (US Patent 6,352,727).

Regarding Claims 11, 12, 17 and 18 Kurschner et al. disclose a method of sterilizing poultry meat (Abstract) comprising the step of subjecting the poultry meat to a contact treatment with a solution during the poultry processing for the production of poultry meat; wherein the contact treatment is carried out at least in one step in the poultry processing comprising plural treatment steps (column 2, lines 19-25)(Kurschner et al.) as well as in one interval between consecutive two steps in the treatment steps (column 3, lines 26-32)(Kurschner et al.); wherein the treatment step is selected from the group consisting of an evisceration step, a chilling step, and a wrapping step (column 1, lines 12-57)(Kurschner et al.); wherein the contact treatment occurs in the interval between the evisceration step and the chilling step (column 3, lines 26-32)(Kurschner et al.). Kurschner et al. do not teach the use of the contact treatment

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being a hinokitiol solution. However, Nishimoto et al. teach the use of an aqueous antibacterial solution of hinokitiol for disinfection purposes (Abstract) for use in food factories (column 9, lines 4-6). Further, Takahashi teaches that hinokitiol cannot only be used to treat meat processing equipment but can also be used to treat the meat itself (column 7, lines 30-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made by modifying the antibacterial solution of Kurschner et al. by substituting the antibacterial solution hinokitiol as taught by Nishimoto et al. to sterilize poultry meat during processing. Further, Takahashi teaches that the hinokitiol solution has a wide range of uses such as sterilizing utensils or sterilizing meat. As such this would only be the substituting of one well known sterilizing agent for another.

Re- Claims 13,14,19 and 20, the combination of Kurschner et al. as modified by Nishimoto et al. and Takahashi discloses all the claimed features including wherein the concentration of hinokitiol in the solution is from 1-50000 ppm (column 8, lines 54-60)(Nishimoto et al.); and wherein the aqueous hinokitiol solution has a PH of 4 to 11 (column 11, lines 45-47)(Nishimoto et al.).

Re- Claims 15 and 21, the combination of Kurschner et al. as modified by Nishimoto et al. and Takahashi discloses all the claimed features including wherein the contact treatment is carried out at a temperature of 0° to 70° C (column 3, lines 26-32)(Kurschner et al.).

Re- Claims 16 and 22, the combination of Kurschner et al. as modified by Nishimoto et al. Takahashi and discloses all the claimed features including wherein the

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contact treatment is accomplished by a method consisting of applying a coat (column 3, lines 42-48)(Kurschner et al.), or spraying (column 3, lines 26-27)(Kurschner et al.), or immersion (column 3, lines 28-29)(Kurschner et al.).

### ***Response to Arguments***

The declaration filed May 6, 2003 and the most current declaration filed October 2, 2003 (not signed) have been considered. In order to advance prosecution the October 2, 2003 declaration has been considered for its content even though not signed and as such cannot be positively taken to have any weight at the present time. Both declarations are directed to the benefits of using hinokitiol solution for treating poultry and the results of such treatment. However, the new grounds of rejection utilizing the Takahashi reference clearly teaches that the use of hinokitiol to treat meat is well known in the art. As such there is no new or unexpected result gained by Applicant that hasn't already been used by others. While, the declaration points to the results obtained using the hinokitiol solution it does not provide any evidence to suggest that their solution works any different or better than the solution advanced by Nishimoto et al. and Takahashi. In light of the above the declarations are not seen to overcome the new grounds of rejection applied in this Office Action.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Watanabe (5,093,140), Hayakawa (5,527,492), Otsu et al. (5,696,169), Beerse et al. (5,968,539), Saito et al. (6,025,312), Makamura (6,043,287), Romano et al.

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(6,048,836), Tozaka (6,183,748), Iwai (6,387,417), Fukazawa et al. (EP 0 180 468 A2), Iwai (JP 2002238524 A), Iwai (EP 1 190 715 A1), Morimura et al. (JP 02138933 A) and Uno et al. (JP 07327638 A).

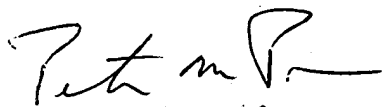
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joan M. Olszewski whose telephone number is 703-305-2693. The examiner can normally be reached on Monday-Friday (5:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on 703-308-2574. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Joan M. Olszewski  
Examiner  
Art Unit 3643

JMO  
October 16, 2003

  
PETER POON  
SUPERVISOR  
TECHNICAL CENTER  
PETER 3600

10/16/03